

Accordingly, applicants have introduced new Claims 37 and 38 to further bring out specific forms of the cosmetic preparations defined in Claim 18. The recited preparation forms are addressed on page 29, indicated lines 33 and 34, of the application, and the corresponding hair cosmetics are addressed on page 9, indicated lines 36 and 37, of the application. Additionally, applicants have added new Claims 39 to 46 to further bring out certain pharmaceutical preparations which inter alia require

- (concerning Claims 39 and 40) that the pharmaceutical is an application form and is in form of a solution or a spray adapted for the application to skin or to a mucous membrane²⁾;
- (concerning Claims 41 and 42) that the polymer formed from constituents (a) and (b) be present in amounts of from 0.5 to 20% by weight, based on the total weight of the preparation³⁾;
- (concerning Claims 43 and 44) that the active ingredient be distributed in a polymer matrix comprising the polymer formed from constituents (a) and (b)⁴⁾; and
- (concerning Claims 45 and 46) that the preparation be coated, that the coating have a thickness of from 5 to 200 μm , and that the coating comprise the polymer formed from constituents (a) and (b)⁵⁾.

No new matter has been added.

The Examiner objected to applicants' claims inter alia raising the question whether the "and" in line 3 of Claim 9 should be deleted. In applicants' opinion the wording of Claim 9 in the referenced section is proper because the section provides for an enumeration of the constituents (a) and (b) of the monomer mixture. The Examiner also noted that the claim identifier of Claim 35 was inaccurate. Applicants have canceled Claim 35 with this paper and have updated the claim identifier accordingly. In light of the foregoing and the attached it is therefore respectfully requested that the claim objections be withdrawn. Favorable action is solicited.

2) Cf. applicants' disclosure on page 6, indicated lines 17 to 26, of the application, and previous Claim 29.

3) Cf. applicants' disclosure on page 9, indicated lines 11 to 17, of the application, and previous Claim 30.

4) Cf. applicants' disclosure on page 6, indicated lines 2 to 4, in conjunction with page 6, indicated lines 43 to 47, of the application, and previous Claim 30.

5) Cf. applicants' disclosure on page 8, indicated lines 10 to 12, of the application, and previous Claim 30.

The Examiner rejected applicants' Claims 24 to 26, 29 to 31 and 35 under 35 U.S.C. §102(e) as being anticipated by the teaching of **Beckham et al.** (US 6,191,215). Withdrawal of the respective rejection is respectfully solicited in light of applicants' cancellation of Claims 24 to 26, 29 to 31 and 35.

The Examiner rejected applicants' Claims 9, 11 to 23 and 32 to 36 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of **Beckham et al.** (ibid.) when taken in view of the disclosure of **Sramek** (US 4,871,521) and of **Habeck et al.** (JP 10/158,140). Withdrawal of the respective rejection is respectfully solicited to the extent that it relates to Claims 32 to 36 in light of applicants' cancellation of those claims.

As concerns the rejection to the extent that it pertains to the subject matter of applicants' Claims 9 and 11 to 23

applicants, by undersigned attorney, hereby state that, at the time the invention disclosed and claimed in application Serial No. 10/069,463 was made, the invention was subject to an obligation of assignment to, and the invention disclosed and claimed by Beckham et al. in US 6,191,215 was owned by, BASF Aktiengesellschaft.

In light of the provisions set forth in 35 U.S.C. §103(c), the teaching of **Beckham et al.** is therefore not prior art which is applicable under Section 103(a) to the claims in this application⁶). Withdrawal of the rejection of Claims 9 and 11 to 23 under Section 103(a) is therefore also respectfully solicited.

Correspondingly, the subject matter of applicants' new Claims 37 to 46 is not rendered unpatentable under Section 103(a) by the teaching of **Beckham et al.** when taken alone or when taken in view of the disclosure of **Sramek** and of **Habeck et al.** Additionally, applicants herewith present a Terminal Disclaimer disclaiming the terminal part of a patent granted on this application which would extend beyond the expiration date of **US 6,191,215**, and agreeing that a patent granted on this application shall be enforceable only for and during such period that the legal title of such patent is the same as the legal title to **US 6,191,215**. The teaching of **Beckham et al.** when taken alone or when taken in view of the disclosure of **Sramek** and/or of **Habeck et al.** can, therefore, also not give rise to a rejection under the judicially created doctrine of obviousness-type double patenting.

6) Cf. MPEP §2146 in conjunction with MPEP §706.02(1)-§706.02(1)(3).

Further, the subject matter of applicants' new Claims 37 to 46 cannot be regarded as being anticipated under Section 102(e) by the teaching of *Beckham et al.* (*ibid.*). Anticipation under Section 102 can be found only if a reference shows exactly what is claimed⁷⁾, and the test for anticipation is one of identity, which means that the identical invention must be shown in the reference in as complete detail as is contained in the claim⁸⁾, including the part-to-part relationships which is set forth in the claims and which gives those claims their meaning⁹⁾. A generic disclosure which merely encompasses the claimed subject matter is therefore not sufficient to establish anticipation within the meaning of Section 102¹⁰⁾.

- Applicants' new Claims 37 and 38 depend upon Claim 18 and therefore incorporate the features of Claims 18 and 9 by reference. Neither Claim 9 nor Claim 18 was included in the Examiner's rejection under Section 102(e) based on the teaching of *Beckham et al.*, and new Claims 37 and 38 can therefore not be regarded as being anticipated by that teaching¹¹⁾.

- Applicants' new Claims 39 and 40 require that the pharmaceutical is an application form and is in form of a solution or a spray adapted for the application to skin or to a mucous membrane. The teaching of *Beckham et al.* merely provides that polyoxyalkylene-poly-siloxane copolymers can be employed in pharmaceutical preparations as auxiliaries, for example as table disintegrants¹²⁾ and does not show a combination of a pharmaceutically active ingredient and a polyoxyalkylene-polysiloxane copolymers which is in form of a solution or a spray. As such, the teaching of *Beckham et al.* cannot be considered to show exactly what is claimed or to describe applicants' applica-

7) Cf. *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (CAFC 1994).

8) Cf. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (CAFC 1989).

9) Cf. *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (CAFC 1984).

10) Cf. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (CAFC 1985); *In re Marshall* 577 F.2d 301, 198 USPQ 344 (CCPA 1978); *In re Kalm* 378 F.2d 959, 154 USPQ 10 (CCPA 1967); see also *Corning Glass Works v. Sumitomo Electric U.S.A.*, 868 F.2d 1251, 9 USPQ2d 1962 (CAFC 1989), which holds that a genus does not inherently disclose all species; and *In re Jones*, 958 F.3d 347, 21 USPQ2d 1614 (CAFC 1992), which holds that a genus does not render all species that happen to fall within the genus obvious.

11) If an independent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (CAFC 1988)). Anticipation is the ultimate or epitome of obviousness (*In re Grose*, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979)).

12) Cf. col. 12, indicated lines 4 to 6, of *US 6,191,215*.

tion form in the specificity which is required for a finding of anticipation under Section 102.

- Applicants' new Claims 41 and 42 require that the polymer formed from constituents (a) and (b) be present in the pharmaceutical preparation in amounts of from 0.5 to 20% by weight, based on the total weight of the preparation. **Beckham et al.**'s remark that polyoxyalkylene-polysiloxane copolymers can be employed in pharmaceutical preparations is by far too generic to show exactly what is claimed by applicants or to identically describe applicants' preparation as is required for a finding of anticipation under Section 102.

- Applicants' new Claims 43 and 44 require that the active ingredient be distributed in a polymer matrix comprising the polymer formed from constituents (a) and (b). An auxiliary may be incorporated into a pharmaceutical formulation in many ways which do not necessarily result in a preparation wherein the active ingredient is distributed in a matrix comprising the auxiliary. **Beckham et al.**'s remark that polyoxyalkylene-polysiloxane copolymers can be employed in pharmaceutical preparations as an auxiliary is therefore also too generic to be considered as an identical description of applicants' preparation, and the teaching of **Beckham et al.** falls short from providing a disclosure which anticipates applicants' invention within the meaning of Section 102.

- Applicants' new Claims 45 and 46 require that the pharmaceutical preparation be coated, that the coating have a thickness of from 5 to 200 μm , and that the coating comprise the polymer formed from constituents (a) and (b). Again, **Beckham et al.**'s remark that polyoxyalkylene-polysiloxane copolymers can be employed in pharmaceutical preparations as auxiliaries is too generic to show exactly what is claimed by applicants or to identically describe applicants' preparation as is required for a finding of anticipation under Section 102.

In light of the foregoing and the attached, applicants' claims as herewith presented are deemed to be patentable under the provisions of Section 102 and 103 as well as under the judicially created doctrine of obviousness-type double patenting. Favorable action by the Examiner is respectfully solicited.

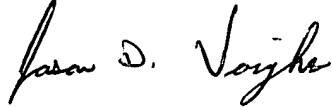
REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a one month extension of time

be granted in this case. The respective \$120.00 fee is paid by credit card (Form PTO-2038 enclosed).

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,
NOVAK DRUCE DELUCA & QUIGG



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Encl.: CLAIM AMENDMENTS (Appendix I)
Terminal Disclaimer concerning *US 6,191,215*

JDV/BAS